

REMARKS

Claims 1-59 are pending in the present Application, and all claims currently stand rejected. Claims 1, 21, 41, and 53 are amended herein. Reconsideration of the Application in view of the foregoing amendments and the following remarks is respectfully requested.

35 U.S.C. § 102(b)

On page 5 of the Office Action, the Examiner rejects claim 42 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 6,006,039 to Steinberg et al. (hereafter 039). The Applicants respectfully traverse these rejections for at least the following reasons.

“For a prior art reference to anticipate in terms of 35 U.S.C. §102, every element of the claimed invention must be *identically* shown in a single reference.” *Diversitech Corp. v. Century Steps, Inc.*, 7 USPQ2d 1315, 1317 (CAFC 1988). The Applicants submit that 039 fails to identically teach every element of the claims, and therefore does not anticipate the present invention.

With regard to claim 42, “means-plus-function” language is utilized to recite elements and functionality similar to those recited in claims 1 and 21, as discussed below. Applicants therefore incorporate those remarks by reference with regard to claim 42. In addition, the Courts have frequently held that “means-plus-function” language, such as that of claim 42, should be construed in light of the Specification. More specifically, means-plus-function claim elements should be *construed to cover the corresponding structure, material or acts*

described in the specification, and equivalents thereof. Applicants respectfully submit that, in light of the substantial differences between the teachings of 039 and Applicants' invention as disclosed in the Specification, claim 42 is therefore not anticipated or made obvious by the teachings of the cited references.

As previously stated, Applicants specifically direct the Examiner's attention to Applicants' discussion of FIG. 8 (Specification, page 14, line 26 through page 16, line 31) which describes in detail the Applicants' claimed invention. Based upon the foregoing remarks, Applicants submit that specific recited limitations of claim 42 have been identified in the Specification and in the arguments made with respect to claims 1 and 21. Because a rejection under 35 U.S.C. §102 requires that every claimed limitation be *identically* taught by a cited reference, and because the Examiner fails to cite 039 to identically teach or suggest the claimed invention, Applicants respectfully request reconsideration and allowance of independent claim 42 so that this claim may issue in a timely manner.

On page 6 of the Office Action, the Examiner rejects claims 21, 47-48, and 50-52 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 6,396,537 to Squilla et al. (hereafter Squilla). The Applicants respectfully traverse these rejections for at least the following reasons.

"For a prior art reference to anticipate in terms of 35 U.S.C. §102, every element of the claimed invention must be *identically* shown in a single reference." *Diversitech Corp. v. Century Steps, Inc.*, 7 USPQ2d 1315, 1317 (CAFC 1988). The Applicants submit that Squilla fails to identically teach every element of the

claims, and therefore does not anticipate the present invention.

With regard to the Examiner's rejection of independent claim 21, Applicants respond to the Examiner's §102 rejection as if applied to amended independent claim 21 which now recites "performing on-line management procedures during which a **system user** interactively and manually utilizes said imaging device to remotely view said one or more ancillary data files that are stored on said computer, to remotely manipulate said one or more ancillary data files that are stored on said computer, to then remotely select said one or more ancillary data files that are stored on said computer, and to manually trigger a download of said one or more ancillary data files from said computer to said imaging device, said on-line management procedures occurring while an active bi-directional electronic communication path currently exists from said imaging device to said computer through said distributed computer network" (emphasis added), which are limitations that are not taught or suggested either by the cited reference, or by the Examiner's citations thereto.

Squilla teaches a camera that wirelessly receives content data directly from an "image spot" that is located at an "attraction site." (see column 2, lines 30-65). However, Applicants submit that Squilla fails to teach any sort of on-line procedures that are "manually" performed by a system user, as claimed by Applicants. On the contrary, Applicants submit that Squilla expressly states that "the personality file is used by the respective processors 76, 14 in the image server 70 and the image spot 10 to choose content data" (emphasis added) (see column 6, lines 57-59). For at least the foregoing reasons, Applicants submit

that Squilla fails to teach “on-line management procedures during which a system user interactively and manually utilizes said imaging device to . . .” (emphasis added), as claimed by Applicants.

On page 7 of the Office Action, the Examiner cites column 5 of Squilla against Applicants’ claimed “new composite image.” Applicants respectfully traverse, and submit that Squilla nowhere teaches combining any sort of downloaded ancillary data and captured image data to create a “new composite image,” as recited by Applicants. In particular, Applicants submit that Squilla fails to teach creating “a new composite image that integrates both said image data and at least one of said ancillary data files as a single image” (emphasis added), as claimed by Applicants.

Regarding the Examiner’s rejection of dependent claims 47-48 and 50-52, for at least the reasons that these claims are dependent from an independent claim whose limitations are not identically taught or suggested, the limitations of these dependent claims, when viewed through or in combination with the limitations of the independent claim, are also not identically taught or suggested. Applicants therefore respectfully request reconsideration and allowance of dependent claims 47-48 and 50-52, so that these claims may issue in a timely manner.

With further regard to the rejection of claim 47, the Examiner cites columns 4-5 of Squilla for support. Applicants traverse, and submit that the cited passages of Squilla nowhere teach or suggest the various detailed “off-line procedure” that are recited by Applicants in claim 47. Applicants therefore

request the Examiner to provide such a citation, so that Applicants may respond appropriately.

Because a rejection under 35 U.S.C. §102 requires that every claimed limitation be *identically* taught by a cited reference, and because the Examiner fails to cite Squilla to identically teach or suggest the claimed invention, Applicants respectfully request reconsideration and allowance of claims 21, 47-48 and 50-52, so that these claims may issue in a timely manner.

35 U.S.C. § 103(a)

On page 9 of the Office Action, the Examiner rejects claims 1, 4-11, 13-17, 21, 24-31, and 33-37 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,477,264 to Sarbadhikari et al. (hereafter Sarbadhikari) in view of U.S. Patent No. 6,628,325 to Steinberg et al. (hereafter Steinberg). The Applicants respectfully traverse these rejections for at least the following reasons.

Applicants maintain that the Examiner has failed to make a *prima facie* case of obviousness under 35 U.S.C. § 103(a) which requires that three basic criteria must be met, as set forth in M.P.E.P. §2142:

"First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations"

(emphasis added).

The initial burden is therefore on the Examiner to establish a *prima facie* case of obviousness under 35 U.S.C. § 103(a).

With regard to the Examiner's rejections of independent claims 1 and 21, Applicants respond to the Examiner's §103 rejections as if applied to similarly-amended claims 1 and 21. For example, independent claim 21 now recites "*performing on-line management procedures during which a system user interactively and manually utilizes said imaging device to remotely view said one or more ancillary data files that are stored on said computer, to remotely manipulate said one or more ancillary data files that are stored on said computer, to then remotely select said one or more ancillary data files that are stored on said computer, and to manually trigger a download of said one or more ancillary data files from said computer to said imaging device, said on-line management procedures occurring while an active bi-directional electronic communication path currently exists from said imaging device to said computer through said distributed computer network*" (emphasis added), which are limitations that are not taught or suggested either by the cited reference, or by the Examiner's citations thereto.

In a primary preferred embodiment, Sarabadhikari teaches "an electronic camera for capturing and storing images in a removable storage device which is also preloaded with software for operating the imaging system (see column 2, lines 54-56). Applicants' claims are not directed towards a "removable storage device" as the "data source." In spite of this significant difference, the Examiner persists in analogizing Applicants' "on-line management procedures" to the

simple reading of data from of a memory card physically inserted in the camera device.

The Examiner further asserts that he is giving the claimed limitation of “on-line management procedures” the “broadest reasonable interpretation” (emphasis added). Applicants submit that a “reasonable” person skilled in the art would not interpret an “on-line” management procedure to include merely reading data directly from a local memory stick that is physically coupled to the camera. On the contrary, Applicants submit that one skilled in the art would readily understand the term “on-line” to refer to a state of being actively connected to a distributed computer network (such as the Internet or a local-area network) that is implemented with a substantial number of different distributed remote computers. Sarabadhikari teaches no such arrangement.

In a secondary embodiment shown in FIG. 11, Sarabadhikari alternately teaches that “*instead of using a removeable memory card 24, the image data files 24a and enhancement files 24b could be stored in non-removeable electrically programmable non-volatile memory located **inside** the camera*” (emphasis added) (column 11, lines 19-22). Therefore, any functionalities attributable to the “removable storage device” of Sarabadhikari are related in the FIG. 11 embodiment only to the non-volatile memory “located inside the camera,” and not to the “computer” shown in FIG. 11 of Sarabadhikari.

As specifically disclosed by Sarabadhikari, “[t]he enhancement file would be supplied on a floppy disk, downloaded to the computer 4, and then uploaded by the computer 4 to an electrically erasable firmware memory 36 in the camera”

(column 11, lines 26-29). Therefore, the only disclosed function of the FIG. 11 computer is to provide a passive means of transferring the enhancement file from the original floppy disk to the non-volatile memory “in the camera.”

No examples of Applicants’ specified “on-line management procedures” are disclosed by Sarabadhikari with respect to the FIG. 11 embodiment. For example, the FIG. 11 embodiment of Sarabadhikari nowhere discloses any sort of remotely viewing, manipulating, selecting, or triggering downloads performed by a system user, as claimed by Applicants. Applicants therefore submit that the FIG. 11 “computer” disclosed in Sarabadhikari is in no way analogous to their claimed “data source” that is implemented as “computer in a distributed computer network” to support “on-line management procedures” performed by a system user of a remote camera device, as claimed by Applicants.

On page 8, lines 24-29, Sarabadhikari explicitly teaches that “*the images are transferred from the camera to the computer via the removeable memory, rather than a cable interface. Therefore, the camera does not have to be in the same location as the computer. This makes it possible to view the images from the camera in many different locations . . .*” (emphasis added): Sarabadhikari thus provides specific beneficial teachings against communicating between camera and computer through a “cable interface.” Applicants therefore submit that Sarabadhikari affirmatively *teaches away* from their claimed invention. A prior art reference which teaches away from the presently claimed invention is “strong evidence of nonobviousness.” In re Hedges, 783 F.2d 1038, 228 U.S.P.Q. 2d 685 (Fed. Cir. 1987).

In the current the Office Action, the Examiner concedes, with regard to the teachings of Sarabadhikari, that “a data source being implemented as a computer in a distributed computer network is not taught.” Applicants concur. The Examiner then points to Steinberg to purportedly remedy these deficiencies in Sarabadhikari. Applicants respectfully traverse. Steinberg teaches a discrete external “communication device” that an electronic camera utilizes to send image data over a “communication network” to a “remote computerized destination” (see column 1, line 44, through column 3, line 17). Steinberg explicitly refers to the network computer as a “destination” (FIG. 1), and not as a “source,” as claimed by Applicants.

Applicants submit that Steinberg discloses only a “communications network” and not a “*distributed computer network of multiple remote intercommunicating computers*” (emphasis added), as claimed by Applicants. Applicants submit that the “communications network” of Steinberg consists of a point-to-point physical connection to the single “destination” device, and is therefore not a “distributed computer network of multiple remote intercommunicating computers,” as claimed by Applicants.

In addition, Steinberg is limited to disclosing a discrete and self-contained “communications interface” with its own processor, memory, battery, power supply, and other resources (see FIG. 3). In contrast, Applicants disclose and claim a software-implemented “ancillary data module” that is stored in local camera memory, and that performs the invention under the control of the camera’s CPU. Applicants’ invention is therefore an integral part of the camera,

and not a self-contained discrete “communications interface,” as taught in Steinberg.

Applicants further submit that Steinberg completely fails to teach any sort of “on-line management procedures” performed by the camera, as recited by Applicants. In particular, Applicants submit that the “camera” recited by Steinberg is a completely passive device with respect to receiving any information from a computer in a “distributed computer network.” In contrast, Applicants explicitly recite various different specific types of “on-line management procedures” that are performed by the camera. Applicants therefore submit that Steinberg teaches away from their claimed invention. A prior art reference which teaches away from the presently claimed invention is “strong evidence of nonobviousness.” In re Hedges, 783 F.2d 1038, 228 U.S.P.Q. 2d 685 (Fed. Cir. 1987).

In the Office Action, the Examiner maintains that Steinberg teaches receiving data from a data destination (not data source, as claimed by Applicants). Applicants respectfully submit that Steinberg fails to provide any specific details with regard to receiving data from a remote destination. For example, Steinberg nowhere provides any specific examples of what type of data might be received from the remote destination. In particular, Steinberg nowhere discloses downloading anything resembling Applicants’ claimed “*ancillary data files*.” Furthermore, the primary data flow described in Steinberg (camera to network) is in the opposite direction to the primary data flow recited by Applicants (network to camera).

In the Office Action, the Examiner states that “[i]t would have been obvious . . . to have incorporated a computer in a distributed computer network” Applicants respectfully traverse. Applicants respectfully submit that computer networks have been known in the corresponding art for quite some time. Applicants submit that their unique solution of performing “*on-line management procedures*” to access and utilize their claimed “*ancillary data files*” indicates the clear existence of secondary indicia of non-obviousness. For example, there apparently has been a long-felt need for Applicants’ solution in the relevant technological field. Furthermore, other entities and individuals in analogous arts have apparently failed to successfully overcome the foregoing problems in the manner disclosed by Applicants. For at least the foregoing reasons, Applicants respectfully submit that claims 1 and 21 are not unpatentable in light of the cited references.

Regarding the Examiner’s rejection of dependent claims 4-11, 13-17, 24-31, and 33-37, for at least the reasons that these claims are dependent from respective independent claims whose limitations are not identically taught or suggested, the limitations of these dependent claims, when viewed through or in combination with the limitations of the respective independent claims, are also not identically taught or suggested. Applicants therefore respectfully request reconsideration and allowance of dependent claims 4-11, 13-17, 24-31, and 33-37, so that these claims may issue in a timely manner.

With further regard to the rejections of claims 11 and 31, the Examiner states that Applicants’ claimed “descriptor tag” is “inherently necessary” as

support for the rejections without providing any specific references for support. It appears that the Examiner is utilizing Official Notice without expressly stating so. Applicants submit that the particular combination of claimed limitations would not be obvious to one skilled in the art at the time of the invention. Applicants further submit that the Examiner has improperly utilized Official Notice because the cited limitations are uniquely utilized by the Applicants to produce novel combinations that are not well-known. Applicants therefore respectfully request the Examiner to cite specific references in support of these rejections, and failing to do so, to reconsider and withdraw the rejections of claims 11 and 31, so that these claims may issue in a timely manner.

For at least the foregoing reasons, the Applicants submit that claims 1, 4-11, 13-17, 21, 24-31, and 33-37 are not unpatentable under 35 U.S.C. § 103 over Sarbadhikari in view of Steinberg, and that the rejections under 35 U.S.C. § 103 are thus improper. The Applicants therefore respectfully request reconsideration and withdrawal of the rejections of claims 1, 4-11, 13-17, 21, 24-31, and 33-37 under 35 U.S.C. § 103.

On page 16 of the Office Action, the Examiner rejects claims 2 and 22 under 35 U.S.C. § 103 as being unpatentable over Sarbadhikari in view of Steinberg and further in view of U.S. Patent No. 6,930,709 to Creamer et al. (hereafter Creamer). The Applicants respectfully traverse these rejections for at least the following reasons.

Applicants maintain that the Examiner has failed to make a *prima*

facie case of obviousness under 35 U.S.C. § 103(a). As discussed above, for a valid *prima facie* case of obviousness under 35 U.S.C. § 103(a), the prior art references when combined must teach or suggest all the claim limitations." The initial burden is on the Examiner to establish a *prima facie* case of obviousness under 35 U.S.C. § 103(a).

Regarding the Examiner's rejection of dependent claims 2 and 22, for at least the reasons that these claims are directly dependent from respective independent claims whose limitations are not identically taught or suggested, the limitations of these dependent claims, when viewed through or in combination with the limitations of the respective independent claims, are also not identically taught or suggested. Applicants therefore respectfully request reconsideration and allowance of dependent claims 2 and 22, so that these claims may issue in a timely manner.

In addition, the Court of Appeals for the Federal Circuit has held that "obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching, suggestion, or incentive supporting the combination." In re Geiger, 815 F.2d 686, 688, 2 U.S.P.Q.2d 1276, 1278 (Fed. Cir. 1987). Applicants submit that there is no specific teaching of a combination that would result in Applicants' invention, and therefore the obviousness rejection under 35 U.S.C §103 is not proper.

For at least the foregoing reasons, the Applicants submit that claims 2 and 22 are not unpatentable over the cited references, and that the rejections are thus improper. The Applicants therefore respectfully request reconsideration and

withdrawal of the rejections of claims 2 and 22 so that these claims may issue in a timely manner.

On page 18 of the Office Action, the Examiner rejects claims 3, 23, and 46 under 35 U.S.C. § 103 as being unpatentable over Sarbadhikari in view of Steinberg and further in view of U.S. Patent No. 6,950,130 to Qian (hereafter Qian), and yet further in view of U.S. Patent No. 6,223,190 to Aihara et al. (hereafter Aihara). The Applicants respectfully traverse these rejections for at least the following reasons.

Applicants maintain that the Examiner has failed to make a *prima facie* case of obviousness under 35 U.S.C. § 103(a). As discussed above, for a valid *prima facie* case of obviousness under 35 U.S.C. § 103(a), the prior art references when combined must teach or suggest all the claim limitations." The initial burden is on the Examiner to establish a *prima facie* case of obviousness under 35 U.S.C. § 103(a).

Regarding the Examiner's rejection of dependent claims 3, 23, and 46, for at least the reasons that these claims are dependent from respective independent claims whose limitations are not identically taught or suggested, the limitations of these dependent claims, when viewed through or in combination with the limitations of the respective independent claims, are also not identically taught or suggested. For at least the foregoing reasons, the Applicants submit that claims 3, 23, and 46 are not unpatentable over the cited references, and that the rejections are thus improper. The Applicants therefore respectfully request

reconsideration and withdrawal of the rejections of claims 3, 23, and 46, so that these claims may issue in a timely manner.

On page 20 of the Office Action, the Examiner rejects claims 12 and 32 under 35 U.S.C. § 103 as being unpatentable over Sarbadhikari in view of Steinberg and further in view of Aihara. The Applicants respectfully traverse these rejections for at least the following reasons.

Applicants maintain that the Examiner has failed to make a *prima facie* case of obviousness under 35 U.S.C. § 103(a). As discussed above, for a valid *prima facie* case of obviousness under 35 U.S.C. § 103(a), the prior art references when combined must teach or suggest all the claim limitations." The initial burden is on the Examiner to establish a *prima facie* case of obviousness under 35 U.S.C. § 103(a).

Regarding the Examiner's rejection of dependent claims 12 and 32, for at least the reasons that these claims are dependent from respective independent claims whose limitations are not identically taught or suggested, the limitations of these dependent claims, when viewed through or in combination with the limitations of the respective independent claims, are also not identically taught or suggested. Applicants therefore respectfully request reconsideration and allowance of dependent claims 12 and 32, so that these claims may issue in a timely manner.

In addition, Applicants submit that Aihara is directed towards only creating a "web page." In contrast, Applicants claim creating "*ancillary data files*," and not

a web page. For at least the foregoing reasons, the Applicants submit that claims 12 and 32 are not unpatentable over the cited references, and that the rejections are thus improper. The Applicants therefore respectfully request reconsideration and withdrawal of the rejections of claims 12 and 32 so that these claims may issue in a timely manner.

On page 21 of the Office Action, the Examiner rejects claims 18-20 and 38-41 under 35 U.S.C. § 103 as being unpatentable over Sarbadhikari in view of Steinberg and further in view of U.S. Patent No. 6,177,957 to Anderson (hereafter Anderson). The Applicants respectfully traverse these rejections for at least the following reasons.

Applicants maintain that the Examiner has failed to make a *prima facie* case of obviousness under 35 U.S.C. § 103(a). As discussed above, for a valid *prima facie* case of obviousness under 35 U.S.C. § 103(a), the prior art references when combined must teach or suggest all the claim limitations." The initial burden is on the Examiner to establish a *prima facie* case of obviousness under 35 U.S.C. § 103(a).

Regarding the Examiner's rejection of dependent claims 18-20 and 38-40, for at least the reasons that these claims are dependent from respective independent claims whose limitations are not identically taught or suggested, the limitations of these dependent claims, when viewed through or in combination with the limitations of the respective independent claims, are also not identically taught or suggested. Applicants therefore respectfully request reconsideration

and allowance of dependent claims 18-20 and 38-40, so that these claims may issue in a timely manner.

Furthermore, with regard to claims 18 and 38, the Examiner concedes that Sarbadhikari fails to teach an “off-line management procedure including a file descriptor identification procedure” Applicants concur. The Examiner then points to Anderson to purportedly remedy these deficiencies. Anderson is limited to teaching a camera device that accesses “executable files” from a “flash disk”. Applicants therefore submit that Anderson fails to teach a “data source being implemented as a computer in a distributed computer network,” as claimed by Applicants.

Independent claim 41 has been amended to recite elements and functionality similar to those recited in claim 21, as discussed above. Applicants therefore incorporate those prior remarks by reference with regard to claim 41. For at least the foregoing reasons, the Applicants submit that claims 18-20 and 38-41 are not unpatentable over the cited references, and that the rejections are thus improper. The Applicants therefore respectfully request reconsideration and withdrawal of the rejections of claims 18-20 and 38-41 so that these claims may issue in a timely manner.

On page 26 of the Office Action, the Examiner rejects claim 43 under 35 U.S.C. § 103 as being unpatentable over Sarabadhikari in view of Steinberg and further in view of U.S. Patent No. 6,195,511 to Harada (hereafter Harada). The Applicants respectfully traverse these rejections for at least the following reasons.

Applicants maintain that the Examiner has failed to make a *prima facie* case of obviousness under 35 U.S.C. § 103(a). As discussed above, for a valid *prima facie* case of obviousness under 35 U.S.C. § 103(a), the prior art references when combined must teach or suggest all the claim limitations." The initial burden is on the Examiner to establish a *prima facie* case of obviousness under 35 U.S.C. § 103(a).

Regarding the Examiner's rejection of dependent claim 43, for at least the reasons that this claim is dependent from an independent claim whose limitations are not identically taught or suggested, the limitations of this dependent claim, when viewed through or in combination with the limitations of the independent claim, are also not identically taught or suggested. Applicants therefore respectfully request reconsideration and allowance of dependent claim 43, so that this claim may issue in a timely manner.

In addition, the Examiner states that "Harada is found to teach the rewriting of camera programming . . ." (emphasis added). In contrast, Applicants specifically claim that the ancillary data module "deletes" a local "ancillary data file." Applicants submit that their claimed ancillary data file is not the same as the "camera programming" recited in Harada. Furthermore, Applicants submit that deleting an image data file is not the same as "rewriting" taught by Harada.

For at least the foregoing reasons, the Applicants submit that claim 43 is not unpatentable over the cited references, and that the rejection is thus improper. The Applicants therefore respectfully request reconsideration and

withdrawal of the rejection of claim 43 so that this claim may issue in a timely manner.

On page 27 of the Office Action, the Examiner rejects claim 44 under 35 U.S.C. § 103 as being unpatentable over Sarabadhikari and Steinberg in view of U.S. Patent No. 6,721,001 to Berstis (hereafter Berstis), and further in view of U.S. Patent No. 6,894,694 to Silverbrook et al. (hereafter Silverbrook). The Applicants respectfully traverse these rejections for at least the following reasons.

Applicants maintain that the Examiner has failed to make a *prima facie* case of obviousness under 35 U.S.C. § 103(a). As discussed above, for a valid *prima facie* case of obviousness under 35 U.S.C. § 103(a), the prior art references when combined must teach or suggest all the claim limitations." The initial burden is on the Examiner to establish a *prima facie* case of obviousness under 35 U.S.C. § 103(a).

Regarding the Examiner's rejection of dependent claim 44, for at least the reasons that this claim is dependent from an independent claim whose limitations are not identically taught or suggested, the limitations of this dependent claim, when viewed through or in combination with the limitations of the independent claim, are also not identically taught or suggested. Applicants therefore respectfully request reconsideration and allowance of dependent claim 44, so that this claim may issue in a timely manner.

In addition, 35 U.S.C. §103 requires that an invention be considered "as a whole" when determining if the invention is obvious in relation to prior art. All

elements of the claimed invention must be taken into consideration. Focusing on the obviousness of substitutions and differences, instead of the invention as a whole, is a legally improper way to simplify the difficult determination of obviousness. Hybritech, Inc. v. Monoclonal Antibodies, Inc., 802 F.2d, 1367, 231 USPQ 81 (Fed. Cir. 1986); cert den., 480 U.S. 947 (1987).

Applicants note that the Examiner currently relies on a combination of one primary reference and four additional secondary references to reject Applicants' claim 44 under 35 U.S.C. § 103(a). Applicants respectfully submit that providing proper motivation to combine each cited reference with *all* of the foregoing *substantial number* of other cited references has not been provided, and therefore the rejections under 35 U.S.C. § 103(a) are improper. Applicants further suggest that requiring such an excessively large number of references may reasonably be viewed as evidence of *non-obviousness*, since any teaching or suggestion to combine all five references becomes increasingly remote as the number of cited references increases.

For at least the foregoing reasons, the Applicants submit that claim 44 is not unpatentable over the cited references, and that the rejection is thus improper. The Applicants therefore respectfully request reconsideration and withdrawal of the rejection of claim 44 so that this claim may issue in a timely manner.

On page 29 of the Office Action, the Examiner rejects claim 45 under 35 U.S.C. § 103 as being unpatentable over Sarabadhikari and Steinberg in view of

U.S. Patent No. 6,731,305 to Park et al. (hereafter Park), and further in view of U.S. Patent No. 6,968,058 to Kondoh et al. (hereafter Kondoh), and yet further in view of U.S. Patent No. 5,717,496 to Satoh et al. (hereafter Satoh). The Applicants respectfully traverse these rejections for at least the following reasons.

Applicants maintain that the Examiner has failed to make a *prima facie* case of obviousness under 35 U.S.C. § 103(a). As discussed above, for a valid *prima facie* case of obviousness under 35 U.S.C. § 103(a), the prior art references when combined must teach or suggest all the claim limitations." The initial burden is on the Examiner to establish a *prima facie* case of obviousness under 35 U.S.C. § 103(a).

Regarding the Examiner's rejection of dependent claim 45, for at least the reasons that this claim is dependent from an independent claim whose limitations are not identically taught or suggested, the limitations of this dependent claim, when viewed through or in combination with the limitations of the independent claim, are also not identically taught or suggested. Applicants therefore respectfully request reconsideration and allowance of dependent claim 45, so that this claim may issue in a timely manner.

In addition, 35 U.S.C. §103 requires that an invention be considered "as a whole" when determining if the invention is obvious in relation to prior art. All elements of the claimed invention must be taken into consideration. Focusing on the obviousness of substitutions and differences, instead of the invention as a whole, is a legally improper way to simplify the difficult determination of

obviousness. Hybritech, Inc. v. Monoclonal Antibodies, Inc., 802 F.2d, 1367, 231 USPQ 81 (Fed. Cir. 1986); cert den., 480 U.S. 947 (1987).

Applicants note that the Examiner currently relies on a combination of one primary reference and four additional secondary references to reject Applicants' claim 45 under 35 U.S.C. § 103(a). Applicants respectfully submit that providing proper motivation to combine each cited reference with *all* of the foregoing *substantial number* of other cited references has not been provided, and therefore the rejections under 35 U.S.C. § 103(a) are improper. Applicants further suggest that requiring such an excessively large number of references may reasonably be viewed as evidence of *non-obviousness*, since any teaching or suggestion to combine all five references becomes increasingly remote as the number of cited references increases.

For at least the foregoing reasons, the Applicants submit that claim 45 is not unpatentable over the cited references, and that the rejection is thus improper. The Applicants therefore respectfully request reconsideration and withdrawal of the rejection of claim 45 so that this claim may issue in a timely manner.

On page 30 of the Office Action, the Examiner rejects claims 49 and 53-56 under 35 U.S.C. § 103 as being unpatentable over Squilla in view of Aihara. The Applicants respectfully traverse these rejections for at least the following reasons.

Applicants maintain that the Examiner has failed to make a *prima facie* case of obviousness under 35 U.S.C. § 103(a). As discussed above, for

a valid *prima facie* case of obviousness under 35 U.S.C. § 103(a), the prior art references when combined must teach or suggest all the claim limitations." The initial burden is on the Examiner to establish a *prima facie* case of obviousness under 35 U.S.C. § 103(a).

Independent claim 53 has been amended to recite elements and functionality similar to those recited in claim 21, as discussed above. Applicants therefore incorporate those prior remarks by reference with regard to claim 53. In addition, Applicants submit that Squilla fails to teach ancillary data files that are "limited" to "image data files." On the contrary, Squilla specifically teaches that "[s]uch data may include . . . audio clips or reference material . . ." (see column 4, lines 60-65).

Regarding the Examiner's rejections of dependent claims 49 and 54-56, for at least the reasons that these claims are dependent from independent claims whose limitations are not identically taught or suggested, the limitations of these dependent claims, when viewed through or in combination with the limitations of the independent claims, are also not identically taught or suggested. Applicants therefore respectfully request reconsideration and allowance of dependent claims 49 and 54-56, so that these claims may issue in a timely manner.

With further regard to the rejection of claim 56, the Examiner "takes Official Notice" regarding Applicants' claimed limitations regarding a "video camera." Applicants respectfully traverse, and submit that the particular combination of claimed limitations would not be obvious to one skilled in the art at the time of the invention. Applicants further submit that the Examiner has

improperly utilized Official Notice because the cited limitations are uniquely utilized by the Applicants to produce novel combinations that are not well-known. Applicants therefore respectfully request the Examiner to cite specific references in support of this rejection, and failing to do so, to reconsider and withdraw the rejection of claims 56, so that this claim may issue in a timely manner.

For at least the foregoing reasons, the Applicants submit that claims 49 and 53-56 are not unpatentable over the cited references, and that the rejections are thus improper. The Applicants therefore respectfully request reconsideration and withdrawal of the rejections of claims 49 and 53-56 so that these claims may issue in a timely manner.

On page 34 of the Office Action, the Examiner rejects claims 57-58 under 35 U.S.C. § 103 as being unpatentable over Squilla and Aihara in view of '039. The Applicants respectfully traverse these rejections for at least the following reasons.

Applicants maintain that the Examiner has failed to make a *prima facie* case of obviousness under 35 U.S.C. § 103(a). As discussed above, for a valid *prima facie* case of obviousness under 35 U.S.C. § 103(a), the prior art references when combined must teach or suggest all the claim limitations." The initial burden is on the Examiner to establish a *prima facie* case of obviousness under 35 U.S.C. § 103(a).

Regarding the Examiner's rejections of dependent claims 57-58, for at least the reasons that these claims are dependent from an independent claim whose

limitations are not identically taught or suggested, the limitations of these dependent claims, when viewed through or in combination with the limitations of the independent claim, are also not identically taught or suggested. Applicants therefore respectfully request reconsideration and allowance of dependent claims 57-58, so that these claims may issue in a timely manner.

For at least the foregoing reasons, the Applicants submit that claims 57-58 are not unpatentable over the cited references, and that the rejections are thus improper. The Applicants therefore respectfully request reconsideration and withdrawal of the rejections of claims 57-58, so that these claims may issue in a timely manner.

On page 35 of the Office Action, the Examiner rejects claim 59 under 35 U.S.C. § 103 as being unpatentable over Squilla, Aihara, Qian, Berstis, and Silverbrook. The Applicants respectfully traverse these rejections for at least the following reasons.

Applicants maintain that the Examiner has failed to make a *prima facie* case of obviousness under 35 U.S.C. § 103(a). As discussed above, for a valid *prima facie* case of obviousness under 35 U.S.C. § 103(a), the prior art references when combined must teach or suggest all the claim limitations." The initial burden is on the Examiner to establish a *prima facie* case of obviousness under 35 U.S.C. § 103(a).

Regarding the Examiner's rejection of dependent claim 59 for at least the reasons that this claim is dependent from an independent claim whose

limitations are not identically taught or suggested, the limitations of this dependent claim, when viewed through or in combination with the limitations of the independent claim, are also not identically taught or suggested. Applicants therefore respectfully request reconsideration and allowance of dependent claim 59, so that this claim may issue in a timely manner.

In addition, 35 U.S.C. §103 requires that an invention be considered “as a whole” when determining if the invention is obvious in relation to prior art. All elements of the claimed invention must be taken into consideration. Focusing on the obviousness of substitutions and differences, instead of the invention as a whole, is a legally improper way to simplify the difficult determination of obviousness. Hybritech, Inc. v. Monoclonal Antibodies, Inc., 802 F.2d, 1367, 231 USPQ 81 (Fed. Cir. 1986); cert den., 480 U.S. 947 (1987).

Applicants note that the Examiner currently relies on a combination of one primary reference and four additional secondary references to reject Applicants’ claim 59 under 35 U.S.C. § 103(a). Applicants respectfully submit that providing proper motivation to combine each cited reference with *all* of the foregoing *substantial number* of other cited references has not been provided, and therefore the rejections under 35 U.S.C. § 103(a) are improper. Applicants further suggest that requiring such an excessively large number of references may reasonably be viewed as evidence of *non-obviousness*, since any teaching or suggestion to combine all five references becomes increasingly remote as the number of cited references increases.

For at least the foregoing reasons, the Applicants submit that claim 59 is not unpatentable over the cited references, and that the rejection is thus improper. The Applicants therefore respectfully request reconsideration and withdrawal of the rejection of claim 59 so that this claim may issue in a timely manner.

Summary

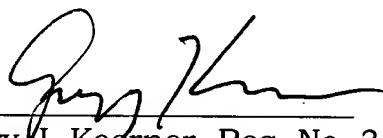
Applicants submit that the foregoing amendments and remarks overcome the Examiner's rejections. Because the cited references, or the Examiner's citations thereto, do not teach or suggest the claimed invention, and in light of the differences between the claimed invention and the cited prior art, Applicants therefore submit that the claimed invention is patentable over the cited art, and respectfully request the Examiner to allow claims 1-59 so that the present Application may issue in a timely manner. If there are any questions concerning this amendment, the Examiner is invited to contact the Applicants' undersigned representative at the number provided below.

Respectfully submitted,

Date: _____

2/19/08

By: _____



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